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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963.

MINNESOTA MINING AND MANUFACTURING COMPANY, a Delaware corporation,
Petitioner,

vs.

THE PLYMOUTH RUBBER COMPANY, INC.,
a Massachusetts corporation,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT.

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November 4, 1963

The Scheffer Press, Inc.—ANdover 3-6850

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT.

To the Honorable, the Chief Justice and the Associate Justices of the United States Supreme Court:

Petitioner, Minnesota Mining and Manufacturing Co., respectfully prays for the issuance of a Writ of Certiorari to review the Judgment of the United States Court of Appeals for the First Circuit entered in the above entitled action on July 15, 1963. The aforesaid Judgment of the Court of Appeals modified a judgment entered by the District Court from which both parties had appealed. A Petition for Rehearing, filed by petitioner, was denied by the Court of Appeals on August 5, 1963.

OPINIONS BELOW.

The opinion of the District Court is reported at 203 F. Supp 595 and has been annexed to this petition as Appendix A. The opinion of the Court of Appeals is reported at 321 F. 2d 151, 138 U.S.P.Q. 344 and is annexed hereto as Appendix B.

JURISDICTION.

The Judgment of the Court of Appeals was entered on July 15, 1963 and is annexed hereto as Appendix C. A separate judgment dismissing Respondent's appeal is annexed hereto as Appendix D. The Petition for Rehearing was denied on August 5, 1963 (Appendix E to Petition).

The jurisdiction of this Court is invoked under 28 U.S.C. 1254 (1).

QUESTION PRESENTED.

In respect to the issue of infringement of a patent, is a patent owner estopped from receiving a determination on the merits by a judgment of another court in a prior suit between the parties which held the article there adjudicated not equivalent to that of the patent, where the article accused in the subsequent action was neither known, nor in issue, nor actually tried by the first court in making its determination.

STATUTE INVOLVED.

This action arises under the Patent Laws of the United States. The question here presented involves principles of *res judicata* and collateral estoppel. No specific statute is involved.

STATEMENT.

Minnesota Mining and Mfg. Co. is the owner of Oace Reissue Patent No. 23,843. The patent covers a stretchable and retractable vinyl plastic adhesive tape designed primarily for insulating splices in electrical conductors, and which was "a great improvement over prior insulating devices and met with much commercial success" (R. 413). Minnesota Mining manufactures and sells this tape under its "Scotch" trademark. Respondent, The Plymouth Rubber Co., also manufactures and sells stretchable and retractable vinyl plastic electrical tape.

In essence, the invention of the patent is in providing a tape wherein the vinyl film backing is sufficiently plastic, *i.e.*, stretchable and retractable, while at the same time remaining permanently compatible with the pressure sensitive adhesive with which it is coated. The patentees found that if the vinyl film were plasticized solely with a low molecular weight, liquid plasticizer, the plasticizer had a tendency to migrate out of the vinyl film and into the adhesive. This caused the adhesive, in time, to become soft or pasty. The patentees also found that if, on the other hand, the film backing was plasticized solely with a high molecular weight, resinous plasticizer, prolonged contact between the adhesive and the film caused the adhesive to lose its desired tackiness (R. 416).

The patentees solved this problem by providing for the use of a plasticizer system comprised of a mixture of both a "low-molecular-weight" material and a "high-molecular-weight, resinous" material (R. 416). When the vinyl film is plasticized in this manner, the adhesive layer neither softens nor loses tackiness even after prolonged contact with the film. The patent describes this condition as one in which the film and the adhesive are in "permanent equilibrium".

In the first suit between the parties,[1] The District Court for the Middle District of North Carolina held the Oace Reissue patent valid and infringed. The Court of Appeals for the Fourth Circuit reversed on the issue of infringement, rejecting the finding of the District Court that the plasticizers used in the tapes made at that time by Plymouth were the equivalent of the plasticizers described and claimed in the patent. Subsequently, the Court also denied Minnesota's motion to reopen the case on the basis of newly discovered evidence and, in so doing, reaffirmed its previous holding of non-infringement on the ground that in no event could the tapes there accused by Minnesota be equivalent to those of the patent.

The basis for the Fourth Circuit's holding was its determination that the tapes there involved were plasticized solely with high molecular weight, resinous materials (such as those referred to by trademark designations, G-25 and G-40) and that such tape did not employ any liquid, migratory plasticizer (such as DOP). Against this determination, Minnesota contended that even though Plymouth had not used any low molecular weight (below 1000), liquid plasticizer, it had, instead, substituted a high molecular weight (from 1000 to 50,000), resinous plasticizer which included within it a greater portion of relatively low weight material, *i.e.*, in the range just above 1000, than did the resinous plasticizers contemplated by the patent. The Court denied, however, that this portion of the high weight resinous plasticizer which included a number of molecules of "relatively low weight" but nevertheless above 1000 was the equivalent of the liquid migratory plasticizer described

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[1] *Minnesota Mining & Mfg. Co.* v. *Sears, Roebuck & Co. and The Plymouth Rubber Co.*, M. D., N.C., 1956, 141 F. Supp. 686; *rev'd.* 4 Cir., 1957, 243 F.2d 136; rehearing denied, 249 F.2d 66. For convenience, this litigation is sometimes referred to as the "Sears case".

in the patent. The Fourth Circuit said (243 F.2d 136 at 143):

> "Even if it be supposed that the composition of G-25 has been so changed as to contain a larger number of molecules of relatively low weight than the G-25 produced during the experimental period, and that by reason of this change it is now possible to use resinous material as a sole plasticizer, its use in making an insulating tape would not constitute infringement, because the plasticizer would still be completely resinous whereas the patent teaches that a liquid as well as a resinous plasticizer must be used."

Shortly after the Fourth Circuit had denied Minnesota's motion to reopen, Plymouth began selling its "Slipknot" tape which if advertised as "new", as resulting from "years of research and months of testing", and as having "a wider temperature working range." (R. 603, 607). Minnesota charged infringement by this tape, asserting that the plasticizer system employed by Plymouth in making its new "Slipknot" tape is the equivalent of the plasticizers of the patent, and departs from that adjudicated in the *Sears* case. The present declaratory judgment action resulted.

In support of its allegation of infringement, Minnesota offered evidence showing that the Slipknot tape contains plasticizer material which is partly of high molecular weight, but a substantial percentage of which has a molecular weight well below 1000 (R. 180, 255) and that such low molecular weight material is also:

(1) a "migrating" type of plasticizer (Bond, Lundquist, etc. R. 182, 185, 207-8, 213);

(2) one which "would function in the same way" as the dioctyl phthalate (DOP) of the patent (R. 257); and

(3) one which would "produce a similar effect" to that of DOP, where the "mechanisms would be quite similar" (R. 257).

Indeed, the record in this case shows, without contradiction, the presence of an identifiable substance which is of low molecular weight and is both non-resinous and migrating: Plymouth's expert, DeBell, accepted, without reservation, the word of Bond and Lundquist, that the low weight portion in the Slipknot tape, if used alone, does migrate (R. 294, 296). This proof is wholly unlike that before the Fourth Circuit wherein the evidence showed the presence of a completely resinous plasticizer (R. 424) in which even the "relatively low weight" molecules were 1000 or more in molecular weight (R. 633). Moreover, the plasticizer before the Fourth Circuit, unlike that here involved, contained no molecules which were migrating, nor which functioned in the same manner as the liquid plasticizers described in the patent (R. 633).

The Courts below in the present case, however, refused to make fact findings or even consider on the merits the issue of infringement by the Slipknot tape. Instead, they held, without the finding of any subsidiary or evidentiary facts to support the conclusion, that the Fourth Circuit had previously decided on what was non-equivalent to the tape of the patent, and that Minnesota was barred by that determination. The evidence offered by Minnesota to prove that the Slipknot tape and the low weight plasticizer therein, unlike that previously adjudicated in the *Sears* case, is the full equivalent of the tape of the patent was wholly ignored. And in response to Minnesota's contention that it is entitled to a determination on the merits as to whether the tape here accused falls within the range of equivalents properly accorded the patent, the Court of Appeals said (App. B to Pet., p. 22a):

"Basic principles of *res judicata* and estoppel by judgment bar relitigation of these matters. As between the parties, they are settled once and for all.".

REASONS FOR GRANTING THE WRIT.

The decision of the courts below, barring a determination on the merits of Minnesota's claim that Plymouth's new Slipknot tape constitutes an infringement of the Oace patent, is erroneous and in apparent conflict with decisions of this Court. The decision represents a departure from principles long fundamental in the application of the doctrines of *res judicata* and collateral estoppel.

1. The decision of the courts below conflicts with principles of law announced and applied by this Court in *Cromwell* v. *County of Sac*, 94 U.S. 351; *Russell* v. *Place*, 94 U.S. 606; and *Commissioner* v. *Sunnen*, 333 U.S. 591.

The controlling law was succinctly stated in *Cromwell*, 94 U.S. at 352-3:

> ". . . it should be borne in mind, as stated by counsel, that there is a difference between the effect of a judgment as a bar or estoppel against the prosecution of a second action upon the same claim or demand, and its effect as an estoppel in another action between the same parties upon a different claim or cause of action. In the former case, the judgment, if rendered upon the merits, constitutes an absolute bar to a subsequent action . . ."
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> "But where the second action between the same parties is upon a different claim or demand, the judgment in the prior action operates as an estoppel only as to those matters in issue or points controverted, upon the determination of which the finding or verdict was rendered. In all cases, therefore, where it is sought to apply the estoppel of a judgment rendered upon one cause of action to matters arising in a suit upon a different cause of action, the inquiry must

always be as to the point or question actually litigated and determined in the original action, not what might have been thus litigated and determined . . ."

Similarly, in *Russell* v. *Place*, 94 U.S. at 608:

"It is undoubtedly settled law that a judgment of a court of competent jurisdiction, upon a question directly involved in one suit, is conclusive as to that question in another suit between the same parties. But to this operation of the judgment it must appear, either upon the face of the record or be shown by extrinsic evidence, that the precise question was raised and determined in the former suit . . ."

The error of the Courts below in the instant case was in failing to give effect to these and similar pronouncements of the law. Thus, the courts held that Minnesota was barred by the prior determination of the Fourth Circuit, even though the "precise question" here raised was not, and could not have been, raised or adjudicated in the former suit.

There can be no real dispute on the basis of the record, that neither the tape nor the plasticizer adjudicated in the Fourth Circuit is precisely the same as the Slipknot article here accused.[2] For example the record herein

[2] Although the District Court concluded, rather vaguely, that "Slipknot tape is made from the same materials and in the same manner as the tape held to be non-infringing" in the Fourth Circuit (App. A to Pet., p. 8a), it failed to meet the requirement of making "such subsidiary findings of fact as will support the ultimate conclusion reached" (*Kweskin* v. *Finkelstein*, 7 Cir., 1955, 223 F.2d 677, 678), or of making findings "sufficient to indicate the factual basis for the ultimate conclusion" (*Kelley* v. *Everglades*, 319 U.S. 415, 422). Significantly, neither court below was able to find that the plasticizers were identical as to their low molecular weight and migratory characteristics.

conclusively proves, through formal admissions of Plymouth, that the plasticizer of the tape involved in the *Sears* case contained no molecules below 1000 in molecular weight (R. 633-4). Moreover, no portion of that plasticizer was a migrating plasticizer (R. 633). Instead, each of the molecules in the earlier Sears tape was non-migratory and therefore resinous.

The Slipknot tape here accused, on the other hand, contains subsfantial quantities of a plasticizer with an average molecular weight of between 600 and 700 (R. 180, 255). This fact was uncontradicted in the courts below. Moreover, similar undisputed proof shows the presence in Slipknot tape of such a separate plasticizer, which material is migrating, and is migrating because of its form and low molecular weight (R. 182, 185, 207-8).

The Court of Appeals recognized, in part, Minnesota's contention with regard to these differences in the two tapes. The Court said (App. B to Pet. p. 23a):

> "On its appeal Minnesota contends that the court below erred because it 'treated as binding on the issue of infringement an earlier decision between the same parties in the Fourth Circuit, although the article here accused was not and could not there have been involved, and is shown by the evidence herein to be different in the very respect which was pertinently involved in the Fourth Circuit's reversal of its District Court in that earlier case.' Minnesota says that this is so because admissions of fact in evidence in this case 'showed that there was no low molecular weight (below 1000) plasticizer in the tapes adjudicated non-infringing in the Sears case. On the other hand, undisputed evidence in the record here shows that the tape here accused has a substantial content of liquid, low molecular weight (below 1000) plasticizer in it'."

The Court answered this contention by holding that Minnesota was estopped to rely upon these and other differences between the plasticizers of the two tapes. The basis for the estoppel was held to be the Fourth Circuit's determination that the completely resinous, non-migrating plasticizer there involved, although having a "larger number of molecules of relatively low weight" but above 1000, was nevertheless not the equivalent of the low weight, liquid migrating plasticizer of the Oace patent. The Court said (App. B. to Pet., p. 24a):

> "Minnesota, in trying to show the presence of low-molecular-weight material in Plymouth's 'Slipknot' tape, is simply trying to relitigate a matter already judicially determined in prior litigation with Plymouth. Its argument, therefore, overlooks, or seeks to evade, the holding of the Court of Appeals for the Fourth Circuit in the *Sears* case. The true issue here, as the court below recognized, is not whether Plymouth is using a resinous plasticizer with low-molecular-weight material in it. In prior litigation between the parties it has been judicially determined that it can."

It is submitted that the courts below erred in not deciding, on the merits, whether the proven differences between the tape adjudicated in the *Sears* case, on the one hand, and that of Slipknot, on the other, were such as to bring the latter within the range of equivalents accorded to every patent, including that of Oace *et al.* The holding that Minnesota is barred from raising this issue by reason of prior litigation between the parties involving an article different from that here accused, is erroneous and in conflict with fundamental principles announced by this Court.

2. The question raised by this petition is one of substance and is of public importance in the future administration of the patent laws.

As was recognized by this Court in *Graver* v. *Linde*, 339 U.S. 605, 607, one who seeks to infringe a patent "may be expected to introduce minor variations to conceal and shelter the piracy" and that

> "Outright and forthright duplication is a dull and very rare type of infringement."

The rule that every patent is entitled to protection, not only as to the exact thing disclosed, but as to things equivalent as well, evolved in recognition of this experience. The range of equivalents to be accorded a patent is said to depend upon the scope and value of the invention.

If the decision of the courts below in the instant case is allowed to stand, it will become authority under which future defendants in patent litigation may gain partial immunity from liability and, hence, shield their infringement. Thus a defendant who has successfully proved that his accused article is outside the range of equivalents of a patent, may then be induced to move his operation closer to the teachings of the patent—on the premise that principles of *res judicata* will bar litigation on the merits as to the equivalency of the modified accused article. By effectively denying the patent owner its day in court, the piracy of inventions will be encouraged.

The dangers inherent in any such extension of the doctrines of *res judicata* or collateral estoppel were recently recognized by this Court in connection with the enforcement of the anti-trust laws. In *Lawlor* v. *National Screen Service*, 349 U.S. 322, 329, the Court said:

> "Acceptance of the respondents' novel contention would in effect confer on them a partial immunity from civil liability for future violations. Such a result is consistent with neither the antitrust laws nor the doctrine of *res judicata*."

CONCLUSION.

The resolution of the question presented is basic to the administration of the patent laws and a matter of public interest. It is submitted that for the foregoing reasons, the petition should be granted.

Respectfully submitted,

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APPENDIX A

UNITED STATES DISTRICT COURT
District of Massachusetts

Civil Action
No. 58-1222-C

PLYMOUTH RUBBER COMPANY, INC.,
Plaintiff

v.

MINNESOTA MINING and MANUFACTURING COMPANY,
Defendant

OPINION

March 23, 1962

CAFFREY, *D.J.*

This an action brought under 28 U.S.C.A. 2201, 2202, in which Plymouth Rubber Company, Inc. seeks declaratory relief against Minnesota Mining and Manufacturing Company. Plaintiff seeks a determination that Minnesota's Oace Reissue Patent, No. 23,843, is not infringed by "Slipknot," plastic electrical insulating tape manufactured and sold by Plymouth, and, also, requests an injunction against Minnesota's bringing or threatening to bring any additional suits against Plymouth or any of its customers based on the manufacture, use, or sale of Slipknot tape by Plymouth or by any of its customers.

In its answer Minnesota asserts that its Oace patent was duly and lawfully issued, is valid, and that Plymouth has infringed and is continuing to infringe same. Minne-

sota also says that the tape in issue here is different from a tape previously determined to be non-infringing in earlier litigation between the same parties which resulted in the entry of a judgment in Plymouth's favor with respect to the tape there in issue.

Minnesota's answer also includes a counterclaim against Plymouth, a prayer for an accounting to establish Minnesota's damages resulting from the alleged infringement, and a prayer for a permanent injunction restraining Plymouth from further infringement.

Plymouth filed a reply to Minnesota's counterclaim in which it challenges the validity of the reissue patent. Thereafter, Judge McCarthy allowed Minnesota's motion to strike so much of Plymouth's reply to the counterclaim as put in issue the validity of the Oace reissue patent, on the ground that the patent had been held to be valid in an earlier case. (See 185 F.Supp. 716.) At the trial of this case I declined to review Judge McCarthy's allowance of the motion to strike, despite urgings of Plymouth's counsel that I do so, since I am persuaded that it is not the proper function of one district judge to review rulings made by another member of the same Court at an earlier stage of a pending case. Any rights that Plymouth may have by reason of my declining to reconsider this matter are expressly saved for purposes of appeal.

At the trial each party produced several chemical experts, all duly qualified to express opinions on the various chemical problems presented by this case. Because of the extensive litigation which has already taken place between these two parties with respect to this particular patent, I do not find it necessary to analyze this expert testimony in fine detail or at length.

For present purposes the most important case in this litany of litigation[1] is the so-called "*Sears*" case, which

[1] In addition to the *Sears* case, the following cases are among those which have been reported:
Minnesota v. *Plymouth* (and Hawkins Electric Company, Complete Electrical Supply Co., and Shumway-Fresen Co.),

was filed on August 3, 1954, by Minnesota against Sears, Roebuck & Company, in the Middle District of North Carolina. Plymouth intervened in that case and openly and actively defended on behalf of its customer, Sears, Roebuck. The District Court ruled that Minnesota's Oace patent was valid and was infringed by the tape which Plymouth was making at that time. Its opinion is reported in 141 F.Supp. 686. On appeal the Court of Appeals for the Fourth Circuit, in an opinion dated April 1, 1957 (243 F.2d 136), reversed and vacated the judgment of the District Court. Thereafter, on October 18, 1957, Minnesota's petition for reopening and rehearing was denied (249 F.2d 66), certiorari was denied (355 U.S. 932), and a motion for rehearing the petition for certiorari was denied on March 17, 1958 (356 U.S. 915). Final judgment was entered by the District Court on May 22, 1958, dismissed Minnesota's complaint.

The Court of Appeals for the Fourth Circuit found the Oace patent teaches that a liquid plasticizer must be used

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[1] (Continued)
178 F.Supp. 591 (N.D. Ill., March 27, 1959); (complaint, filed Aug. 4, 1954, dismissed on Plymouth's motion for summary judgment, and Minnesota's motion for leave to file a supplementary complaint denied);

Minnesota v. *Superior Insulating Tape Co.*, 124 P.Q. 31 (E.D. Mo.), aff'd. 284 F.2d 478 (8 Cir., Dec. 1, 1960), (complaint, filed Aug. 4, 1954, dismissed on defendant's motion for summary judgment, and Minnesota's motion for leave to file a supplementary complaint denied);

Minnesota v. *U.S. Rubber Co.* (and Lowder Hardware Co. and Rockingham Hardware Co.), and v. *Goodyear Tire & Rubber Co.* (and Carolina Tire Co. of Thomasville, N.C.), 178 F. Supp. 385 (M.D.N.C.), aff'd. 279 F. 2d 409 (4 Cir., May 16, 1960), (complaints, filed June 15 and July 5, 1956, dismissed on Plymouth's motions for summary judgment, and Minnesota's motion for leave to file a supplementary complaint denied).

Minnesota also secured default judgment against *Pine State Electric Supply Co.* on complaint filed in M.D.N.C. August 3, 1954. Plymouth was not a party to this case, which involved two tapes, only one of which was made by Plymouth.

together with a resinous plasticizer, such as G-25 or G-40, in order to obtain good results in the manufacture of insulating adhesive tape. The Court specifically rejected the contention made by Minnesota that this patent teaches that the low molecular-weight portions of a resinous plasticizer are equivalent to those of a liquid plasticizer, and ruled that since Plymouth omitted from the production of its tapes the liquid plasticizer element, as specified in the claims of the patent, there could be no infringement of the patent even though the same results were obtained. The Court refused to apply the doctrine of equivalents because it was satisfied that one element required by the Oace patent, namely the liquid plasticizer, was not included in Plymouth's product.

In still another phase of this apparently interminable multi-facet litigation, the Court of Appeals for the Eighth Circuit construed the Sears decision as holding that "plaintiff's patent teaches that the plasticizer of the tape must consist of two elements, one liquid and one resinous, and that the Plymouth product did not infringe because its plasticizer contained only the resinous element and not the liquid element."

Minnesota contends herein that Slipknot is a different tape from that involved in the *Sears* case and that Slipknot infringes the Oace reissue patent because of an alleged change in the composition of G-25 and G-40. Minnesota says that subsequent to August 3, 1954, G-25 and G-40 have been materially changed so that they now contain, in effect, the elements of a liquid plasticizer as that term is used in the Oace patent. Minnesota does not attempt to prove this by any direct evidence tending to establish a change in the raw materials from which G-25 and G-40 are manufactured, nor by any direct evidence of a change in the process used to manufacture G-25 and G-40. Minnesota seeks to prove that a change occurred by offering in evidence the results of certain fractionation tests made by its experts upon substances extracted by these experts from samples of Slipknot tape.

I am persuaded and accordingly I find that Plymouth's Slipknot tape, brought onto the market under that trade name in December 1957, is made in the same way and from the same materials as the Plymouth tape ruled to be non-infringing by the Court of Appeals for the Fourth Circuit in the *Sears* case. I base this finding primarily, but by no means exclusively, on the testimony of Dr. Ellington M. Beavers, Assistant Director of Research for Rohm & Haas Company, the chemical concern which manufactures Paraplex G-25 and Paraplex G-40. Dr. Beavers took part in the development of G-25 and G-40. He testified that prior to the commercial marketing of either of these resinous polymeric plasticizers, definite specifications were developed for the manufacture of each, and he testified explicitly that there has been no change in the specifications of G-25 since August 3, 1954, and that there have been no significant changes in the manufacturing processes of either plasticizer since that time.[2]

He further testified that the acid number specification has remained a maximum of 2 for each product; that the raw materials used for each have remained the same; that the production control methods have remained the same; that the products have continued to be as uniform as is possible; and that Rohm & Haas Company is selling today[3] the same products as G-25 and G-40 as it did on or before August 3, 1954.

Dr. Beavers' testimony was followed by testimony from Morris M. Danovitch, Chief Chemist for Plymouth's tape and cable division, to the effect that he was responsible for the formulation of Plymouth's plastic electrical tape. He stated, in substance, that there had been no change in Plymouth's method of manufacture since prior to August 3, 1954. He further testified that all formulas specify

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[2] This testimony is corroborated in part by Defendant's Exhibit A, a letter written on December 29, 1954 on behalf of Rohm & Haas Company, in which it was stated that there has been no significant change in these resinous plasticizers.

[3] March 10, 1961 was the date of this testimony.

that G-40 or G-25 be used as the sole plasticizer in the manufacture of Slipknot tape. This witness was followed by Solomon C. DeJong, foreman of Plymouth's calender room, who testified that the materials used in the actual making of Slipknot were mixed in strict accordance with Danovitch's formulas.

The testimony of these three witnesses, which dealt directly with the manufacturing and supplying of G-25 and G-40 by Rohm & Haas Company, and the manufacturing of Slipknot tape by Plymouth, was corroborated by evidence from the experimental field. Plymouth produced as its expert Mr. John M. DeBell, who has an impressive background and vast experience in the field of synthetic resins and plastics (indeed, this statement might fairly be made with reference to all the chemical experts who testified at the trial). Mr. DeBell, a former director of research at the Massachusetts Institute of Technology, now is the head of his own consulting laboratory, DeBell & Richardson, which employs over one hundred people and which does extensive consultation and testing work for the major companies in the chemical industry in the United States. He tested both the tape involved in the *Sears* case and the tape involved in this case, and he previously testified as Plymouth's expert during the trial of the *Sears* case. Mr. DeBell stated that his laboratory tests indicated no change in the plasticizer used by Plymouth in the two tapes tested. His tests showed the absence of a liquid plasticizer.

I believe these wifnesses, both because they impressed me as credible and truthful witnesses and because there was no direct challenge to their testimony as to continued identity of raw materials and manufacturing processes. Minnesota's evidence consisted mostly of the results of certain experimental tests conducted by its chemical experts. I do not believe these tests go far enough to require the disbelief of any of the foregoing testimony. The so-called fractionation tests are similar to those upon which Minnesota relied in its motion for rehearing in the *Sears* case and in its motions for leave to file supple-

mentary complaints in other cases cited in footnote No. 1, *supra*.

Minnesota claims the tests show that the low molecular weight fractions of the plasticizer extracted from the backing of Slipknot tape is such as to be either a liquid plasticizer similar to that called for by its Oace patent or sufficiently similar to be an equivalent to it. This is essentially the same argument which Minnesota presented to the Court of Appeals for the Fourth Circuit when it sought reopening of the *Sears* case. That Court specifically rejected this argument by saying:

> ". . . even if the new evidence should demonstrate the alleged change in the composition of G-25, the decision of the Court would necessarily be retained. This is so because G-25, although changed to contain a larger quantity of low molecular weights, would nevertheless be a resinous plasticizer and would not be composed partly of a resinous and partly of a liquid plasticizer in accordance with the teaching of the patent." (249 F.2d 66, 67.)

I, likewise, do not find sufficient merit in the argument presented by Minnesota here to overcome the plaintiff's evidence.

I think it significant that all of Minnesota's experts avoided the use of a distillation test which Mr. DeBell testified was a simple, reliable and objective test for determining the presence of liquid plasticizer, the ingredient which the Court of Appeals for the Fourth Circuit held to be an indispensable element under the teachings of the Oace patent.

Minnesota makes the further contention that when Plymouth brought Slipknot on to the market in 1957 it launched an extensive nationwide advertising campaign heralding Slipknot as its "new" tape. Minnesota says that this advertising should be treated by this Court as an admission that Slipknot was a "different" tape from that sold by Plymouth prior to 1957, and on the basis

of the chemical evidence in the case, Minnesota argues that this "different" tape should be found to be an infringing tape. Plymouth, on the other hand, says that the tape was "new" in the sense that the nationwide advertising program would introduce it to a group of customers 95% of whom were previously unaware that Plymouth manufactured and marketed a plastic electrical insulating tape, that for this reason it was "new" to this 95% of the trade, and that it was also "new" in that the thickness of the particular tape involved had been reduced from 8 to 7 mil.

The evidence shows that Plymouth conducted an elaborate advertising campaign as alleged, and also used the catch line "ZF-90 for total adhesion." This may well have been over-promotion with regard to the degree of newness, and could well be criticized as rather shabby hucksterism on the part of Plymouth's sales promotion personnel. Nevertheless, the use of mysterious and technical-sounding letter-number combinations for supposedly potent ingredients in a wide diversity of products is a matter of everyday experience.* This use of over-exuberant advertising fails to overcome the evidence reviewed in earlier portions of this opinion which satisfies me that the tape involved herein is chemically not different from the tape involved in the *Sears* case.

I find that Plymouth's Slipknot tape is made from the same materials and in the same manner as the tape held to be non-infringing by the Court of Appeals for the Fourth Circuit in the *Sears* case, and I rule that Slipknot does not infringe Oace Reissue Patent, No. 23,843.

There remain two questions, the first of which is whether Plymouth should be granted the injunctive relief

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* A casual reading of the advertising material in the daily papers in any metropolitan area or in any of our national magazines will show that the admen of Madison Avenue are saturating advertising copy with such items as GL-70 and BR-85 in toothpaste, TCP in motor oil, V-7 and VO-5 in hair tonic, AT-7 in soap etc., etc.

it seeks. In the leading case in this area of the law, *Kessler* v. *Eldred*, 206 U.S. 285 (1907), wherein the Supreme Court upheld the granting of an injunction against further suits sought by a party who previously had successfully resisted a charge of patent infringement, the Court said, (at page 289):

> ". . . the question here is whether by bringing a suit against one of Kessler's customers, Eldred has violated the right of Kessler. The effect which may reasonably be anticipated of harassing the purchasers of Kessler's manufactures by claims for damages on account of the use of them, would be to diminish Kessler's opportunities for sale. *No one wishes to buy anything, if with it he must buy a lawsuit.* . . . If rights between litigants are once established by the final judgment of a court of competent jurisdiction, those rights must be recognized in every way, and wherever the judgment is entitled to respect by those who are bound by it." (Emphasis added.)

The language in plaintiff's brief (page 12) aptly describes the instant litigation:

> "The customer cases constitute a story of proliferation of litigation on a single issue, abuse of judicial process, persistent trying of identical issues in different courts, and oppression and harassment unequalled in our experience. We know of nothing quite like it in the reported cases."

Apart from the instant case, which was begun by Plymouth, Minnesota has thus far instigated litigation against Plymouth and 13 of its customers in United States District Courts located in the Fourth, Seventh, and Eighth Circuits. Minnesota has been unsuccessful in every one of these cases in which Plymouth has appeared and defended. Its conduct in connection with this litigation has already been criticized by the Courts of Appeal for the Fourth and Eighth Circuits. The Fourth Circuit criticized the conduct of one Harold J. Kinney, an attorney for Minnesota, who has appeared in substantially

all of these cases, observing, with reference to an affidavit filed by Mr. Kinney in connection with the *U. S. Rubber* case:

> "The Kinney affidavit adds no weight to plaintiff's position. Aside from its impropriety as an effort on the part of an attorney to bolster his client's case by giving factual testimony on his client's behalf, the affidavit is obviously based only on information and belief, derived from Rathmann, and does not represent the testimony of one who has personal knowledge of the essential facts." (279 F.2d 409, 415.)

The Court of Appeals for the Eighth Circuit expressed its impatience with Minnesota's behavior in the *Superior Insulating Tape* case, saying:

> "The record here also shows that the trial of this case was stayed for some four years upon plaintiff's (Minnesota) motion representing that the pending North Carolina cases would dispose of the controversy without the necessity of a trial. . . . There is reason to believe that there should be some limit to the number of times the Courts should be required to consider claims involving identical issues." (284 F.2d 478, 482.)

Needless to say, Minnesota has not abided by the outcome of the North Carolina litigation. The conduct of Minnesota with reference to the multitudinous actions it has filed in connection with its Once patent can be accurately characterized by the language of Judge Kaufman in *Helene Curtis Industries* v. *Sales Affiliates*, 105 F.Supp. 886, 902, aff'd. 199 F.2d 732 (2 Cir. 1952):

> "Defendant is forum shopping with a vengeance. I discern no other rationale which can adequately explain the stratagems which it has employed throughout this controversy. *Our courts are not meant for such use.*" (Emphasis added.)

While a final judgment completely disposing of this case will not be entered simultaneously with the filing of this opinion, for reasons set forth in the succeeding paragraph, a temporary injunction pending entry of final judgment will be filed herewith enjoining Minnesota, its attorneys, agents, and employees, from instituting any further or additional litigation against Plymouth or any of its distributors or customers based on alleged infringement of Oace Reissue Patent, No. 23,843, by Plymouth's Slipknot tape.

The final question raised by the pleadings is whether or not an attorney's fee should be awarded to Plymouth. It is clear, under 35 U.S.C.A. 285, that an attorney's fee is to be awarded only in the exceptional case. Exceptional cases, for purposes of Section 285, are those in which the conduct of the party against whom attorney fees are awarded may be characterized as unfair or vexatious or involving bad faith or some other equitable consideration which makes it unjust that the prevailing party be left to bear the burden of his own counsel fees, which prevailing litigants normally do bear. *Seismograph Service Corp.* v. *Offshore Raydist, Inc.*, 263 F.2d 5, 24 (5 Cir. 1958); *Kemart Corp.* v. *Printing Arts Research Laboratories*, 269 F.2d 375, 394 (9 Cir. 1959). Cf. *Grant Paper Box Company* v. *Russell Box Company*, 106 F. Supp. 616 (D. Mass. 1952), aff'd. 203 F.2d 177, cert. denied 346 U.S. 821, rehearing denied 346 U.S. 905.

I find and rule that the conduct of Minnesota in this case, in which it again is unsuccessfully asserting contentions rejected many times previously by other Federal courts, is both vexatious and unfair, and I award attorney fees to Plymouth. I will hear the parties on the question of the amount of attorney fees to be awarded to counsel for Plymouth.

Minnesota's counterclaim is dismissed and Plymouth will be granted relief in accordance with this opinion.

/s/ Andrew A. Caffrey,
U. S. D. J.

UNITED STATES DISTRICT COURT
District of Massachusetts

Civil Action
No. 58-1222-C

PLYMOUTH RUBBER COMPANY, INC.,
Plaintiff

v.

MINNESOTA MINING AND MANUFACTURING COMPANY,
Defendant

TEMPORARY INJUNCTION
March 23, 1962

Effective upon the filing hereof in the office of the Clerk of this Court and pending entry of final judgment herein, Minnesota Mining and Manufacturing Company, its officers, attorneys, agents, employees, servants, and workmen are enjoined hereby from representing that the manufacture, use, or sale of Slipknot plastic electrical tape made by Plymouth Rubber Company, Inc. is an infringement of Oace Reissue Patent, No. 23,843, and from bringing or threatening to bring, or continuing the prosecution of, any action at law or in equity, against Plymouth Rubber Company, Inc., or any of its customers, based upon the manufacture, use, or sale of said Slipknot tape by Plymouth Rubber Company, Inc. or any of its customers.

By the Court,
/s/ Dorothy C. Clark
Deputy Clerk

Enter:
/s/ Andrew A. Caffrey
Andrew A. Caffrey
U. S. District Judge

APPENDIX B.

UNITED STATES COURT OF APPEALS
For the First Circuit

No. 6040.

THE PLYMOUTH RUBBER COMPANY, INC.,
PLAINTIFF, APPELLANT,

v.

MINNESOTA MINING AND
MANUFACTURING COMPANY,
DEFENDANT, APPELLEE.

No. 6042.

MINNESOTA MINING AND
MANUFACTURING COMPANY,
DEFENDANT, APPELLANT,

v.

THE PLYMOUTH RUBBER COMPANY, INC.,
PLAINTIFF, APPELLEE.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS.
[203 F. Supp. 595]

Before WOODBURY, *Chief Judge*, and HARTIGAN and ALDRICH, *Circuit Judges*.

H. L. Kirkpatrick, with whom *William W. Rymer* was on brief, for The Plymouth Rubber Company, Inc.

Edward A. Haight, with whom *John M. Harrington, Jr., Harold J. Kinney, Stanley G. De La Hunt* and *Ropes and Gray* were on brief, for Minnesota Mining and Manufacturing Company.

OPINION OF THE COURT
July 15, 1963.

WOODBURY, *Chief Judge*. This is another chapter in what the court below aptly called a "litany of litigation" over Reissue Patent No. 23,843 dated June 29, 1954, of original Patent No. 2,559,990 for "Insulating Tape" issued on July 10, 1951, to Oace and others and by them assigned to Minnesota Mining and Manufacturing Company, a Delaware corporation of St. Paul, Minnesota. Once ferreted out the determinative issue on these appeals becomes relatively simple. But to drive the quarry out of its burrow we must analyse the patent and review this and other litigation between the parties over it.

On August 3, 1954, Minnesota brought suit against Sears, Roebuck and Company in the Middle District of North Carolina for infringement of its reissue patent by selling insulating tape manufactured by the plaintiff-appellee herein, The Plymouth Rubber Company, Inc., a Massachusetts corporation with its principal place of business in Canton in that Commonwealth. Plymouth intervened in that suit as a party defendant and conducted the defense of its customer.[1] On the next day, August 4, 1954, Minnesota filed two similar suits, one in the Eastern District of Missouri against another Plymouth customer, which Plymouth actively defended but in which it did not formally intervene, and another in the Northern District of Illinois against Plymouth and six of its customers. Both of these suits were stayed on representations by Minnesota that the North Carolina cases would dispose of the respective controversies without the necessity for trial, and the North Carolina cases in due course went to trial. In that litigation the district court, finding the facts and making the conclusions of law tendered by Minnesota, entered a decree on June

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[1] On the same day Minnesota brought another like suit in the same court against four other Plymouth customers which was consolidated for trial with the suit against Sears in which Plymouth intervened as a defendant.

12, 1956; that its patent was valid and infringed, enjoined Sears and Plymouth from further infringement and referred the question of Minnesota's damages to a master.[2] On Plymouth's appeal the United States Court of Appeals for the Fourth Circuit reversed and remanded. *Sears, Roebuck and Company* v. *Minnesota Mining and Manufacturing Company*, 243 F.2d 136 (C.A. 4, 1957), petition for rehearing and motion to reopen denied, 249 F.2d 66 (C.A. 4, 1957), *cert. denied*, 355 U.S. 932 (1958).

The decisions of the court of appeals in the above case define the issue in the one before us. To understand those decisions, however, we must first turn to the patent itself.

The patented product is a stretchable adhesive plastic tape designed primarily for use by electricians for covering splices in electrical conductors. The problem which Oace and his assistants set out to solve, and apparently solved, was to plasticize a tape backing of polyvinyl chloride in order to make is stretchable and retractable (elastic) in such a way that it would remain in "permanent equilibrium" with a pressure-sensitive adhesive coating. The patentees say in their specification that they obtained their unique and valuable results by "utilizing an insulating tape in the form of a relatively thick but easily stretchable and highly elastic pressure-sensitive adhesive tape comprising a well-bonded, water-insoluble, non-corrosive, normally tacky and pressure-sensitive adhesive coating on a plasticized vinyl chloride polymer film which is in permanent equilibrium with the adhesive." They say that by "permanent equilibrium" they mean

[2] At this juncture Minnesota brought two more similar suits in the same court against two other Plymouth customers. These suits stayed pending appeal in the case against Sears. Upon reversal in that case, the suits were dismissed on Plymouth's motion for summary judgment. (Plymouth was, as the district court notes, "the real party conducting this defense.") *Minnesota Mining & Manufacturing Company* v. *United States Rubber Company* and *Same* v. *Goodyear Tire and Rubber Company, Inc.*, 178 F.Supp. 385 (M.D.N.C. 1959), *modified and affirmed* 279 F.2d 409 (C.A. 4, 1960).

"that the pressure-sensitive adhesive layer neither softens (becomes 'pasty') nor loses tackiness (becomes non-adherent) on prolonged contact with the backing or film layer." Then the patentees go on to say:

> "In order to secure permanent equilibrium between backing and adhesive, we employ with the vinyl chloride polymer a *combination* of modifiers including a substantial but minor amount (not to exceed about 20 parts per 100 parts of the vinyl polymer) of a *low molecular weight liquid* plasticizer such as dioctyl phthalate [or DOP] together with a substantially equal or somewhat greater amount of a *high molecular weight resinous type* plasticizer, the amount of the latter in any event being sufficient, *together with* the liquid plasticizer, to provide the desired degree of stretch in the final film." (Italics supplied.)

The patentees describe a material known to the trade as "Paraplex G-25" as "a preferred example of a suitable resinous type plasticizer." But they say:

> "While resinous or high molecular weight modifiers such as 'Paraplex G-25' are themselves capable of producing the desired degree of strength, stretch and elasticity in vinyl chloride polymer films, and furthermore are generally classed as 'non-migrating' or 'permanent' type modifiers or plasticizers, it is surprisingly found that these materials do not provide for permanent equilibrium of adhesive and backing as herein defined. Instead, it has been shown that pressure-sensitive adhesives in prolonged contact with highly stretchable and elastic films consisting solely of vinyl polymer and resinous modifier lose a great deal, if not all, of their initial tackiness or pressure-sensitivity."

Further emphasizing the necessity for the use of the two types of plasticizers, the patentees say that while the adhesive coating on a tape made from a film of the vinyl chloride polymer plus a resinous plasticizer and a liquid plasticizer in the relative proportions of

100:29.5:17.6 proved to be in "permanent equilibrium" with the backing: "On the other hand, adhesives coated on films plasticized with from 40 to 70 parts of 'Paraplex G-25' and in the absence of the dioctyl phthalate [or DOP, the low-molecular-weight liquid plasticizer mentioned above] were soon found to become deficient in tackiness."

The United States Court of Appeals for the Fourth Circuit in the case cited above construed the claims which it said were typical, that is, claim 1 of the original patent and claim 6 for its reissue, in the light of the specification as covering the use of two separate and distinct kinds of plasticizers, one liquid and the other resinous, which, the court said: ". . . are two well defined and distinctive types of plasticizers, as the language of the specification indicates, which are not only well recognized by the trade but are characterized by substantial differences in chemical composition." Then, finding that Plymouth was using only Paraplex G-40, which it said was a resinous plasticizer similar to Paraplex G-25 but less expensive, as the plasticizer for its polyvinyl chloride film, the court held that Plymouth had not infringed for the reason that even though it obtained the patentees' result it did so by omitting one element covered by the claims of the patent. Wherefore it reversed and remanded.

On Minnesota's petition for rehearing and motion to reopen on the ground of newly discovered evidence, the court of appeals wrote the second opinion cited above reiterating its previous decision that the patent taught that to manufacture the patented elastic, adhesive, insulating tape it was necessary to use both a resinous type and a liquid type plasticizer. And it rejected Minnesota's motion to reopen for the reception of evidence that the composition of Paraplex G-25 had been changed to include a larger proportion of low-molecular-weight plasticizer saying: ". . . the motion to reopen the case for the taking of additional evidence must be overruled, because even if the new evidence should demonstrate the alleged change in the composition of G-25, the de-

cision of the Court would necessarily be retained. This is so because G-25, although changed to contain a larger quantity of low molecular weights, would nevertheless be a resinous plasticizer and would not be composed partly of a resinous and partly of a liquid plasticizer in accordance with the teaching of the patent."

Upon remand the district court on May 20, 1958, issued a decree on the mandate of the court of appeals reversing and setting aside its previous decree and, with costs to the defendants, dismissed Minnesota's complaint with prejudice "for the reasons stated in the opinions and mandate and for no other reason." Elaborating, the district court said that it interpreted the opinions and mandate of the court of appeals as holding no infringement, which the court said was enough in itself to warrant dismissal of the plaintiff's complaint. Then, while commenting that it did not interpret those opinions as holding the patent invalid, the court said that interpretation "is a matter that can be left to any other court."

In the meantime, in December 1957 (or perhaps in January 1958), Plymouth changed the trade name of its tape from either "Homart" or "Plymouth" to "Slipknot" and embarked on an extensive national advertising campaign wherein it proclaimed that "After years of research and months of testing" Plymouth had "at last broken the vinyl tape barrier" with its "New Slipknot Plastic Tape," feats which Plymouth attributed to the addition of "ZF-90," which admittedly was purely an advertising "gimmick," but which it at first described as "Plymouth's new polymeric additive for total adhesion."[3] And at about the same time Plymouth moved for summary judgment in Minnesota's action pending in the Northern District

[3] The court below brushed aside Plymouth's advertising campaign characterizing it as "over-exuberant," "over-promotion" and "rather shabby huckterism." We do the same, for it affords no excuse for Minnesota's attempt to relitigate a matter already judicially determined as between it and Plymouth, as will appear hereinafter.

of Illinois mentioned earlier in this opinion. Minnesota vigorously but unsuccessfully resisted this motion and a like motion in the Missouri litigation. *Minnesota Mining and Manufacturing Company* v. *Plymouth Rubber Company, Inc.*, 178 F.Supp. 591 (N.D.Ill., 1959); *Minnesota Mining and Manufacturing Company* v. *Superior Insulating Tape Company*, 124 U.S. P.Q. 31 (E.D. Mo.), *affirmed* 284 F.2d 478 (C.A. 8, 1960).

While its petition for summary judgment was pending in Illinois, Plymouth on December 30, 1958, brought the present suit against Minnesota in the United States District Court for the District of Massachusetts for a declaratory judgment and injunctive relief.[1] Plymouth alleged in its complaint that litigation in the Fourth Circuit had culminated on May 22, 1958, in a final decree that it had not infringed Minnesota's reissue patent, that at the time of the entry of that decree an action by Minnesota for infringement of its patent was pending in the Northern District of Illinois, that although Plymouth had changed the name of its tape to "Slipknot" it had not changed the composition of its tape "in any substantial or material respect" at any time subsequent to the filing of the Illinois and North Carolina suits, but that nevertheless Minnesota ".... has now asserted in said Illinois suit, in an effort to keep that suit alive, that Plymouth has made and sold, and that its customers named in the Illinois suit have sold, subsequent to the filing of the Illinois suit, 'Slipknot' plastic electrical tape of alleged modified construction infringing said Oace patent and not adjudicated by said North Carolina decree." Wherefore Plymouth asked for a decree that its "Slipknot" tape did not infringe Minnesota's reissue patent, for an injunction forbidding Minnesota from bringing or further prosecuting any suits against Plymouth or its customers based on the manufacture,

[1] Federal jurisdiction is predicated alternatively upon involvement of the patent laws of the United States, Title 28 U.S.C. § 1338(a) or upon diversity of citizenship and amount in controversy, Title 28 U.S.C. § 1332(a)(1).

use or sale of plastic electrical tape made by Plymouth and for costs and a reasonable counsel fee.

Minnesota answered denying Plymouth's assertion that it had not changed the composition of its tape and counterclaimed for infringement, to which Plymouth replied with a denial and the assertion, *inter alia*, that Minnesota's reissue patent was invalid. Minnesota moved to strike that portion of Plymouth's reply which alleged invalidity on the ground that Plymouth was bound by a prior judicial determination that the reissue patent was valid, that is, by the adjudication of the district court in the *Sears* case, and a judge of the court below other than the judge who presided at the trial granted Minnesota's motion. Plymouth, as appellant in No. 6040, challenges the correctness of this ruling in order to protect its right to assert the defense of invalidity in the event that we should reverse the finding of non-infringement made by the court below and thereby render the question of the reissue patent's validity no longer moot.[5]

The decisions of the Court of Appeals for the Fourth Circuit in the *Sears* case determine certain issues as between the parties once and for all. Those decisions construe the patent in issue as calling for the use of two well defined and distinct types of plasticizers, one liquid and the other resinous, which the court said were not only well known and recognized in the art but were characterized by substantial differences in chemical composition.[6] It said:

> "The liquid plasticizers are all monomeric, that is, they are simple, precise and well defined chemical

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[5] "To hold a patent valid if it is not infringed is to decide a hypothetical case." *Altvater* v. *Freeman*, 319 U.S. 359, 363 (1943).

[6] On rehearing the court disposed of Minnesota's argument that the claims of the reissue patent do not call for the use of a liquid plasticizer by saying: "If these claims were taken to mean that a liquid plasticizer is not used, they are void because not supported by the teachings of the original patent."

compounds of low-molecular-weight ranging from 250 to 600. In them every molecule is like every other molecule so that the material cannot be fractionated. It is thinly fluid. DOP for example has a molecular weight of 390 and a viscosity of less than one poise, which is the unit by which viscosities are measured. Resinous plasticizers on the other hand are polymeric. They are synthetic compositions made by combining chemicals of high-molecular weight and are extremely viscous. G-25, for example, has a viscosity of 1000 poises. The molecules of these resins are combinations of varying numbers of so-called building units and accordingly vary in weight, ranging in the case of G-25 from 1000 to 50,000. Its average molecular weight is 8000. It is substantially correct to say that no part of G-25 is liquid and no part of DOP is resinous, as these terms are known to the art."

Then, finding on the record before it that Plymouth was using only a resinous type plasticizer in the fabrication of the tapes alleged to infringe, the court reached the conclusion, noted previously, that the defendants therein, Plymouth and Sears, had not infringed since one of the elements of the patented structure had been omitted in the manufacture of the accused product.

Moreover, on rehearing the court also held that even if G-25 had been changed since it first came on the market in 1944 so as to contain a larger quantity of low-molecular-weight material it would nevertheless remain "a resinous plasticizer and would not be composed partly of a resinous and partly of a liquid plasticizer in accordance with the teaching of the patent."

We presume that the basis for the court's rejection of this evidence was its conclusion that even if a resinous plasticizer contained a significant fraction of low-molecular-weight material, such fraction still would not constitute the "liquid" plasticizer of the Oace patent in the "monomeric" sense in which it had defined a "liquid" plasticizer, that is, as "simple, precise and well-defined

chemical compounds" in which "every molecule is like every other molecule." This presumption is borne out by the Fourth Circuit's repeated rejection of the same type of evidence not only in its opinion denying a rehearing in the *Sears* case but also in its opinion in the *United States Rubber* and *Goodyear* cases cited in footnote 2 above, in which the court said (279 F.2d at 414-15):

> "The molecular weights vary in both kinds of plasticizers but each has its own distinctive form, the liquid plasticizer being monomeric and the resinous plasticizer polymeric in its molecular structure, and it follows that Plymouth's tape did not violate the patent even if it be true . . . that Plymouth has found a way to make a satisfactory tape by using a resinous plasticizer containing a substantial amount of low-molecular-weight material."

In short, it has been held in prior litigation between the parties that Minnesota's reissue patent calls for the use of two types of plasticizers, a low-molecular-weight "monomeric" liquid plasticizer and a high-molecular-weight "polymeric" resinous plasticizer, and that Plymouth did not infringe by using only a resinous type plasticizer even though it might contain a substantial amount of low-molecular-weight material. Basic principles of *res judicata* and estoppel by judgment bar relitigation of these matters. As between the parties, they are settled once and for all.

This was clearly recognized by the court below which rejected the fractionation tests of Minnesota's expert witnesses by which it undertook to prove that the G-25 and G-40 in the "Slipknot" tape differed from the same compounds in Plymouth's earlier tapes in that those plasticizers had been changed to contain a substantial amount of low-molecular-weight material. It said that it did so partly because it believed Plymouth's witness who testified that the formulae for G-25 and G-40 had not been changed over the years, partly because it believed that the fractionation tests of Minnesota's witnesses did not go far enough to establish the presence

of "monomeric" material in the "Slipknot" tape[1] and partly because even if Minnesota's evidence were believed it would constitute the same sort of proof rejected by the court on petition to reopen in the *Sears* case, wherein the court said that proof of a "larger quantity of low-molecular-weights" in Plymouth's resinous plasticizers still would not make it a "liquid plasticizer" as called for by the Oace patent. Wherefore the court ruled that "Slipknot does not infringe Oace Reissue Patent, No. 23,843" and entered judgment giving Plymouth the relief it requested. Minnesota's appeal from this judgment is No. 6042.

On its appeal Minnesota contends that the court below erred because it "treated as binding on the issue of infringement an earlier decision between the same parties in the Fourth Circuit, although the article here accused was not and could not there have been involved, and is shown by the evidence herein to be different in the very respect which was pertinently involved in the Fourth Circuit's reversal of its District Court in that earlier case." Minnesota says that this is so because admissions of fact in evidence in this case "showed that there was no low molecular weight (below 1000) plasticizer in the tapes adjudicated non-infringing in the *Sears* case. On the other hand, undisputed evidence in the record here

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[1] The court said it credited the testimony of Plymouth's independent chemical expert, who said that the distillation test is a simple, reliable and objective test for the presence of liquid plasticizers in the sense of the "monomeric" materials which the court in the *Sears* case had held to be an indispensable element under the teaching of the Oace patent, and who further testified that such tests conducted by him indicated the absence of any appreciable amount of such material in Plymouth's tapes.

We have laboriously waded through Minnesota's evidence in the record, which for us as non-chemist laymen proved an odyssey fraught with obscurity, confusion and frustration. The most we can make of it is that it shows the presence of low-molecular-weight material in the plasticizer used in Plymouth's "Slipknot" tape. Indeed, this is all that Minnesota claims for its evidence in the court below or claims for it on this appeal.

shows that the tape here accused has a substantial content of liquid, low molecular weight (below 1000) plasticizer in it."

Minnesota's contention rests upon the proposition that there was no low-molecular-weight material in the Plymouth tapes held in the *Sears* case not to infringe. The fact, however, is, as we have already been at pains to point out, that the court in the *Sears* case held on Minnesota's motion to reopen, that even though G-25 had been changed since it first came on the market to contain a larger quantity of low-molecular-weights it would nevertheless still be a resinous plasticizer as defined in the patent and not a combination of resinous and liquid plasticizers within the patent's teaching. That is to say, the court held that the presence of low-molecular-weight material in G-25 and similar compounds would not render them any the less resinous plasticizers as defined in the patent.

Minnesota, in trying to show the presence of low-molecular-weight material in Plymouth's "Slipknot" tape, is simply tryng to relitigate a matter already judicially determined in prior litigation with Plymouth. Its argument, therefore, overlooks, or seeks to evade, the holding of the Court of Appeals for the Fourth Circuit in the *Sears* case. The true issue here, as the court below recognized, is not whether Plymouth is using a resinous plasticizer with low-molecular-weight material in it. In prior litigation between the parties it has been judicially determined that it can. The issue here is whether the plasticizer Plymouth is now using is a pre-blend or synthesis of liquid and resinous plasticizers as the Court of Appeals for the Fourth Circuit defined those materials.*

We cannot escape the impression that Minnesota has made no attempt to prove the issue in this case but instead is trying either to further litigate the validity

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* The court in its first opinion in the *Sears* case said that the defendants herein concede that the use of a pre-blended mixture of the two types of plasticizers would be the equivalent of mixing them during the process of production.

of the Fourth Circuit's definition of liquid and resinous plasticizers as those terms are used in the patent or else to ignore that definition on the spurious ground that the meaning of the terms used in the patent was either not directly in issue or else was not the real basis for decision in the *Sears* case. If there is one thing, however, that the *Sears* case ought to have taught Minnesota it is that the term "liquid plasticizer" as used in the patent was directly in issue and was held not to mean a resinous type plasticizer even though such a plasticizer might have low-molecular-weight material in it. There is no excuse for further litigating those issues with Plymouth.

There is no doubt in our minds that Plymouth has made out a case for an injunction in the discretion of the court below. We think it clear that Plymouth is entitled to protect its business from the adverse effects to be anticipated from the harassing of its customers with claims for damages arising out of the use of its products. "No one wishes to buy anything, if with it he must buy a law suit." *Kessler* v. *Eldred*, 206 U.S. 285, 289 (1907). But we think the injunction too broadly drawn in that it enjoins Minnesota from representing that Plymouth's "Slipknot plastic electrical tape" is an infringement of the Oace patent and from bringing any action at law or in equity based upon the manufacture, use or sale of "said Slipknot tape." Identification merely by trade name leaves Minnesota handcuffed in the event Plymouth should apply "Slipknot" to an infringing tape. The injunction should be limited to Plymouth tapes made in substantially the same way from substantially the same materials as those adjudicated non-infringing both by the Court of Appeals for the Fourth Circuit in the *Sears* case and by this court in the case at bar.

From what we have said in this opinion it must be clear that we find no abuse of discretion in awarding Plymouth a counsel fee.

Judgment will be entered dismissing Plymouth's appeal, No. 6040.

In Minnesota's appeal, No. 6042, judgment will be entered affirming the judgment of the District Court as modified in accordance with this opinion.

APPENDIX C.

UNITED STATES COURT OF APPEALS
For The First Circuit

No. 6042.

MINNESOTA MINING AND MANUFACTURING COMPANY,
Defendant, Appellant,

v.

THE PLYMOUTH RUBBER COMPANY, INC.,
Plaintiff, Appellee.

JUDGMENT
July 15, 1963.

This cause came on to be heard on appeal from the United States District Court for the District of Massachusetts, and was argued by counsel.

Upon consideration whereof, It is now here ordered, adjudged and decreed as follows: The judgment of the District Court, as modified in accordance with the opinion filed today, is affirmed, and the case is remanded for such modification.

By the Court:
/s/ Roger A. Stinchfield,
Clerk

[cc: Messrs. Haight and Kirkpatrick.]

APPENDIX D.

UNITED STATES COURT OF APPEALS
For The First Circuit

No. 6040.

THE PLYMOUTH RUBBER COMPANY, INC.,
Plaintiff, Appellant,

v.

MINNESOTA MINING AND MANUFACTURING COMPANY,
Defendant, Appellee.

JUDGMENT
July 15, 1963.

This cause came on to be heard on appeal from the United States District Court for the District of Massachusetts, and was argued by counsel.

Upon consideration whereof, It is now here ordered, adjudged and decreed as follows: The appeal herein is dismissed. No costs.

By the Court:
/s/ Roger A. Stinchfield,
Clerk

[cc: Messrs. Kirkpatrick and Haight.]

APPENDIX E.

UNITED STATES COURT OF APPEALS
For The First Circuit

No. 6042.

MINNESOTA MINING AND MANUFACTURING COMPANY,
Defendant, Appellant,

v.

THE PLYMOUTH RUBBER COMPANY, INC.,
Plaintiff, Appellee.

ORDER OF COURT
August 5, 1963

It is ordered that the petition for rehearing filed on July 29, 1963, be, and the same hereby is, denied.

By the Court:
Roger A. Stinchfield, Clerk.
By: /s/ Dana H. Gallup,
Chief Deputy Clerk.

[cc: Messrs. Haight and Kirkpatrick.]

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Supreme Court of the United States

OCTOBER TERM, 1963

No. 602

MINNESOTA MINING AND MANUFACTURING COMPANY,

Petitioner,

v.

THE PLYMOUTH RUBBER CO., INC.,

Respondent.

BRIEF FOR THE RESPONDENT IN OPPOSITION

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Attorney for Respondent

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Supreme Court of the United States

OCTOBER TERM, 1963

MINNESOTA MINING AND MANUFACTURING COMPANY, *Petitioner*, v. THE PLYMOUTH RUBBER CO., INC., *Respondent*.	No. 602

BRIEF FOR THE RESPONDENT IN OPPOSITION

Opinions Below

The opinion of the District Court is reported at 203 F. Supp. 595. The opinion of the Court of Appeals is reported at 321 F. 2d 151.

Jurisdiction

The jurisdiction of this Court is invoked under 28 U. S. C. § 1254(1).

Questions Presented

1. Was the finding of fact that respondent's product "is made in the same way and from the same materials" as respondent's product earlier held not to infringe petitioner's patent, in a first judgment binding on both parties, clearly erroneous?

2. Was the finding of fact that respondent's product contains no "liquid" plasticizer (absence of which was held

to establish non-infringement, in resolution of the basic question actually litigated and determined, by the first judgment and essentially to it) clearly erroneous?

3. Is not the product's freedom from infringement res judicata, not only because of the above facts and first judgment, but additionally because of further judgments binding on the parties which determined, essentially to each and in each an actually litigated question, that the admittedly same product did not infringe?

Rule Involved

F. R. Civ. P. 52:

"Findings by the Court.

"a. Effect. * * * Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. * * *"

Statement

There are no "special and important reasons" for review on writ of certiorari of the "question presented" by petitioner (Pet. 2). Material facts not set forth by petitioner reveal furthermore not only that the asserted question is hypothetical, but that it would not in any event be dispositive.

As petitioner states (Pet. 3), the patent in suit is concerned with prescribing for use in vinyl plastic a plasticizer of such a nature that it makes the vinyl stretchy enough for adhesive electrical tape without hurting the adhesive.

It had earlier been recognized that a "stretchable and retractable" (like the old rubber tape used for the purpose)

vinyl electrical adhesive tape would be a desirable product (R. 405). However, it had been found that when enough "liquid plasticizer" was used to make the vinyl plastic adequately stretchy, some of it migrated into the adhesive, spoiling it by making it go "pasty" (id.).

In 1943, Rohm & Haas, "a widely known chemical company of Philadelphia, produced a new type of high-molecular-weight resinous plasticizer known as 'Paraplex G-25', which could be combined satisfactorily with vinyl without causing migration." (R. 416, 31). The first production batch of G-25 was in 1944 (R. 32). Using it, petitioner came on the market with its commercial electrical tape in 1945, and filed its patent application in 1946 (R. 416). There is no evidence that any commercial insulating tape has ever been marketed that has not used as a non-migrating plasticizer either G-25 or one which appeared on the market even later.

When the new G-25 was first tried as the sole plasticizer by petitioner, it was found that, far from migrating into the adhesive and making it "pasty", it in time resulted in the adhesive's losing "initial tackiness or pressure-sensitivity" (R. 406). The patentees' "problem" was thus how to achieve "permanent equilibrium", by which they meant "that the . . . /adhesive layer neither softens (becomes 'pasty') [as with liquid plasticizers] nor loses tackiness (becomes non-adherent) [as with resinous plasticizers] on prolonged contact with the backing" (R. 406). Their solution was to use some of each type of plasticizer.

The patent summarizes its teaching thus (R. 406, col. 3, line 21):

> "In order to secure permanent equilibrium between backing and adhesive, we employ with the vinyl chloride polymer a combination of modifiers including a substantial but minor amount (not to exceed about 20 parts per 100 parts of the vinyl

> polymer) of a low molecular weight *liquid plasticizer*, such as dioctyl phthalate, together with a substantially equal or somewhat greater amount of a high molecular weight *resinous type plasticizer*, the amount of the latter in any event being sufficient, together with the liquid plasticizer, to provide the desired degree of stretch in the final film."*

After the Patent Office had twice rejected as unpatentable over prior patents, and as improperly indefinite or functional, originally filed claims specifying plasticizer content much as in the language just quoted (R. 543, 547-8, 558), these claims were canceled and replaced by a narrower one that became (after slight further amendment) the broadest of the original patent (R. 560), and required "a liquid phthalyl ester plasticizer amounting to 8 to 20 parts per 100 parts of [the vinyl] polymer, and a soft and viscous alkyd resin plasticizer". With this same amendment was included these remarks about the cited prior art (R. 566):

> "There is no suggestion of the three-way blend used by applicants, employing the vinyl chloride polymer, the liquid phthalyl ester, and the alkyd resin, *combined together*. That this three-way blend is essential to the success of applicants' product was clearly pointed out in the application as filed." (Emphasis Petitioner's.)

Nevertheless, after respondent (hereinafter sometimes called "Plymouth") had succeeded in formulating and marketing a product in which only resinous plasticizer was used (R. 417), petitioner (hereinafter sometimes called "Minnesota") sought and obtained by reissue (R. 405) claims (numbered 6 through 9, and printed in italics, R. 409-10) in which the plasticizer was defined simply as

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*Emphasis ours throughout this brief unless otherwise noted.

"comprising at least a major proportion of a non-migrating viscous plasticizer resin". This definition purported to be broader even than that of the original claims canceled following rejection; and so broad as to make non-essential the liquid plasticizer taught in the original specification (R. 406), and urged during prosecution (supra 4), to be essential.

Armed with its reissue, Minnesota launched a series of attacks on Plymouth's tapes, against Plymouth and its customers.

Sears, Roebuck & Co. v. *Minnesota Mining & Mfg. Co.*, 243 F. 2d 136 (4 Cir. 1957), on petition for rehearing and motion to reopen 249 F. 2d 66, cert. den'd 355 U. S. 932, reh. den'd 356 U. S. 915, in which Plymouth controlled the defense of its customer Sears, produced the first judgment binding on these parties. In reversing the District Court (Hayes, D. J.), the Court of Appeals, which had before it an extensive record including much testimony by chemist expert witnesses, ruled that there could indeed be no infringement without use of a "liquid" plasticizer. In rejecting Minnesota's argument that the lower molecular weight fractions of the resinous plasticizer were really liquid (243 F. 2d 136, 143-4; R. 424, 425), the Court said:

> "*The evidence clearly shows that there are two well defined and distinctive types of plasticizers*, as the language of the specification indicates, which are not only *well recognized by the trade* but are characterized by substantial differences in chemical composition. The *liquid plasticizers* are *all monomeric* that is, they are simple, precise and well defined chemical compounds of low-molecular-weight ranging from 250 to 600. In them every molecule is like every other molecule so that the material *cannot be fractionated*. It is thinly fluid. DOP for example has a molecular weight of 390 and a viscosity of less than one poise, which is the unit by which vis-

> cosities are measured. *Resinous plasticizers on the other hand are polymeric.* They are synthetic compositions made by combining chemicals of high-molecular-weight and are extremely viscous. G-25, for example, has a viscosity of 1000 poises. The *molecules of these resins are combinations of varying numbers of so-called building units* and accordingly vary in weight, ranging in the case of G-25 from 1000 to 50,000. Its average molecular weight is 8000. *It is substantially correct to say that no part of G-25 is liquid and no part of DOP is resinous, as these terms are known to the art.*
>
> * * *
>
> *"Even if it be supposed that the composition of G-25 has been so changed as to contain a larger number of molecules of relatively low weight* than the G-25 produced during the experimental period, and that by reason of this change it is now possible to use resinous material as a sole plasticizer, *its use in making an insulating tape would not constitute infringement, because the plasticizer would still be completely resinous whereas the patent teaches that a liquid as well as a resinous plasticizer must be used."*

After this decision, Plymouth started selling some of its same old tape, unchanged except in thickness (R. 341), under a different trademark, "Slipknot". This product was advertised as "new", though it perhaps should not have been, even though new "to 95 per cent of our prospects" (R. 338). When Minnesota used this advertising as a pretext for disregarding the res judicata effect of *Sears*, Plymouth brought the present action for declaratory and injunctive relief (R. 8-10).

The District Court heard eleven witnesses. Seven were chemists. Much highly complicated technological evidence was adduced; the Joint Consolidated Record Appendix runs to 653 pages. Of this evidence the Court of Appeals said [Pet. 23a]:

"We have laboriously waded through Minnesota's evidence in the record, which for us as non-chemist laymen proved an odyssey fraught with obscurity, confusion and frustration.")

The District Court had before it also numerous samples of various plasticizer materials submitted in evidence (e.g., Exhibits P, Q, and R introduced by Minnesota, R. 292, 204).

On the basis of all this, the District Court made a finding of fact which Minnesota asks this court to declare, after undertaking on its behalf yet another odyssey through its confusing, frustrating, and sophistical evidence, to be clearly erroneous. The District Court found that the tape in suit "*is made in the same way and from the same materials*" and "*is chemically not different from*" the tape adjudicated in *Sears* (Pet. 5a, 8a). It devoted four printed pages (beginning and ending with those just cited) to expanding on evidentiary and credibility considerations supporting its finding.

(a) It was unquestioned that Plymouth was still using only one of either G-25 or G-40, the same-numbered Rohm & Haas resinous plasticizers litigated in *Sears*, and the District Court believed the testimony of the totally independent and highly expert Assistant Director of Research of Rohm & Haas that G-25 and G-40 had remained unchanged since filing of the complaint in *Sears* (R. 88-9, R. 94, Pet. 5a). This testimony was corroborated by that of Plymouth's expert, Mr. DeBell (R. 292, 297).

(b) The District Court believed the testimony of Plymouth's house chemist and production witnesses that there had been "no change in Plymouth's method of manufacture" (Pet. 5a), rejecting Minnesota's argu-

ment that changes in processing had affected the plasticizer.

(c) The District Court found that Mr. DeBell's "tests showed the absence of a liquid plasticizer" (Pet. 6a). It found Minnesota had introduced no direct evidence to the contrary, and found (Pet. 7a) it "significant that all of Minnesota's experts avoided the use of a distillation test which Mr. DeBell testified was a simple, reliable and objective test for determining the presence of liquid plasticizer, the ingredient which the Court of Appeals for the Fourth Circuit held to be an indispensable element. . . ." It found (Pet. 6a) Minnesota's "so-called fractionation tests . . . similar to those upon which Minnesota relied in its motion for rehearing in the *Sears* case and in . . . other cases" involving these parties.

The very fact that the lower molecular weight material had to be separated out by fractionation (because part of a polymeric distribution curve continuum, R. 112, 119, 309, 517), rather than distillation, showed the plasticizer not to be monomeric or liquid, as that issue was adjudicated bindingly on these parties in *Sears* (supra 5), as emphasized in *United States Rubber* (infra 11).

The Court of Appeals disagreed with none of the above findings. It emphasized that the absence of any "liquid" plasticizer, as that term was bindingly adjudicated between these parties in *Sears*, was dispositive, and said (Pet. 24a-25a):

> "We cannot escape the impression that Minnesota has made no attempt to prove the issue in this case but instead is trying either to further litigate the validity of the Fourth Circuit's definition of liquid and resinous plasticizers as those terms are

used in the patent or else to ignore that definition on the spurious ground that the meaning of the terms used in the patent was either not directly in issue or else was not the real basis for decision in the *Sears* case. If there is one thing, however, that the *Sears* case ought to have taught Minnesota it is that the term 'liquid plasticizer' as used in the patent was directly in issue and was held not to mean a resinous type plasticizer even though such a plasticizer might have low-molecular-weight material in it. There is no excuse for further litigating those issues with Plymouth."

The judgment below was neither the second binding on these parties nor the first to adjudicate the very issue of *Sears*' res judicata effect on the Slipknot-branded tapes. *Sears* was only one of many suits Minnesota brought against Plymouth or its customers.

The second judgment binding on these parties was pursuant to *Minnesota Mining & Mfg. Co.* v. *Plymouth Rubber Co.*, 178 F. Supp. 591 (N. D. Ill. 1959). This Chicago action was filed by Minnesota against Plymouth (a Massachusetts company) and a customer the day after Minnesota had sued Sears (a Chicago company) in North Carolina. When Plymouth moved for summary judgment on the ground that *Sears* was res judicata, Minnesota urged (just as it is still doing) that when Plymouth began using the trademark "Slipknot" it changed its plasticizer from that adjudicated in Sears.* Whether *Sears* was res judicata

*Minnesota relied also on an extraordinary affidavit of Mr. Kinney (whose name has from the beginning of this interminable litigation appeared always as of counsel, often as affiant, and on occasion as asserted expert) which baldly attacked the correctness of the decision of the Court of Appeals for the Fourth Circuit, asserting its conclusion of lack of "significant" change in G-25 to be based on hearsay and contrary to the evidence (R. 56). Its

of Slipknot tape, the very product now before this Court, was then actually litigated. "Many affidavits, counter-affidavits, and reply affidavits" were filed (R. 53). In determining this precise question against Minnesota, the Court held that even if a change of the sort asserted by Minnesota had been made, *Sears* was nevertheless res judicata.*

The third judgments binding on these parties were pursuant to *Minnesota Mining & Mfg. Co.* v. *United States Rubber Co.*, 279 F. 2d 409 (4 Cir. 1960; R. 431). Here Minnesota urged that Plymouth's plasticizer had been changed before the complaints in the two customers suits resolved by this decision were filed, well after the *Sears* complaint. Minnesota attempted to show the change by "accepting the statements of Plymouth's affiants that its formulas

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position today is not essentially different, even though semantically more subtle.

*The Court said (R. 57; 178 F. Supp. 591, 595):

> "In fact, the only possibility of change in the plasticizer which the affidavits may be said to reveal is that which may have occurred in late 1957 and early 1958 when concededly the name of the brand of the product was changed and plaintiff's chemist Rathmann's analysis intimates the plasticizer could not be characterized as 'entirely resinous' and contained such 'low molecular weight material' and was 'fluid'.
>
> "The Court is of the opinion from a reading of the two opinions of the Fourth Circuit that any of the asserted and alleged changes which may have been made in Plymouth's product were passed upon by that Court, precluding this Court's review thereof as between the same parties."

A fully alternative ground of decision was that there was no cause of action when the complaint was filed (of which *Sears* was admitted to be res judicata, since the complaints were filed only a day apart), and that a complaint defective in this respect could not be cured through reliance on subsequent events. That these two grounds were alternative and each equally essential to the judgment granting summary judgment is made clear in the District Court's detailed opinion, in which following initial statement of this resolution of the matter (178 F. Supp. 591, 595; R. 57) it was restated in unusual outline form (178 F. Supp. 591, 595-6; R. 58).

have remained the same since the *Sears* case [because the Slipknot branded tapes appeared after even the later complaints] and by showing through analysis that Plymouth's more recent tapes [i.e., the Slipknot branded tapes] contain the liquid element." *Minnesota Mining & Mfg. Co.* v. *United States Rubber Co.*, 279 F. 2d 409, 411 (4 Cir. 1960). Thus, once more, an actually litigated and judgment-determining question became whether Slipknot-branded material infringed. In holding *Sears* res judicata to the contrary, the Court said (279 F. 2d 409, 414-5; R. 441):

> "The molecular weights vary in both kinds of plasticizers but each has its own distinctive form, the liquid plasticizer being monomeric and the resinous plasticizer polymeric in its molecular structure, and it follows that Plymouth's tape did not violate the patent even if it be true, as Rathmann [Minnesota's affiant] suggests, that Plymouth has found a way to make a satisfactory tape by using a resinous plasticizer containing a substantial amount of low-molecular-weight material."

Argument

This case turns, not on the "question presented" by petitioner, but on factual questions dependent on the weighing of complicated chemical evidence including the testimony of numerous expert witnesses. The asserted question would only arise if the District Court's finding of tape sameness were clearly erroneous, as it is not. Even then the asserted question would not be dispositive, in view of the correct concurrent findings of fact by both lower courts that Plymouth's tapes included no "liquid" plasticizer, as was bindingly held essential to infringement in *Sears*. Furthermore, dispositive significance is denied petitioner's asserted question in view of other binding adjudications that Slip-

knot-branded tape itself does not infringe. Further review is not warranted, no question of general interest or importance is involved, and we submit that the time has come when Plymouth should be allowed the fruits of its expensive, long defense of its right of fair competition.

1. The petitioner's "question presented" does not even arise unless the District Court was clearly erroneous in finding that the tape here involved was the same and "chemically not different" from that adjudicated in *Sears*. This finding was not wrong, and there is no other reason justifying Minnesota's request that this Court repeat again the Court of Appeals' "odyssey fraught with obscurity, confusion and frustration" through "Minnesota's evidence in the record" (Pet. 23a).

a. Petitioner's attempt to dispose in a footnote (Pet. 8) of this finding of fact as "vague" and inadequately supported by "subsidiary" findings is without merit. It ignores not only the subsidiary findings set forth in the four pages of the opinion already referred to (Pet. 5a-8a), but also that the finding that the tape was made in the same way from the same materials was itself a primary finding of fact, unlike the ultimate conclusions of the two decisions petitioner cites.*

*In *Kweskin* v. *Finkelstein*, 223 F. 2d 677, 678 (7 Cir. 1955), "The only finding of fact made . . . in addition to the place of residence of each of the parties, was that plaintiff failed to prove the material allegations of the complaint." In *Kelley* v. *Everglades District*, 319 U. S. 415 (1943), the conclusion was that a particular plan of composition under the Bankruptcy Act was "fair, equitable, and for the best interests of the creditors and does not discriminate unfairly" (footnote, p. 421); but this was the issue of law.

In *Kelley*, this Court said (319 U. S. 415, 419):

> "The nature and degree of exactness of the findings required depends on the circumstances of the particular case."

b. In implicitly urging that the District Court finding is clearly erroneous, Minnesota ignores altogether the extensive evidence to the contrary on which the District Court relied (supra 7-8). Instead it argues that (1) the plasticizer in *Sears* included no molecules of molecular weight under 1000, while (2) the plasticizer here contains some (unknown amount, infra 17) of such material, wherefore the plasticizers must be different. The afterthought nature of this "under 1000" argument is apparent from the fact that it did not occur to Minnesota to make it in any of the Chicago, *United States Rubber*, or *Superior* (infra 19) cases, though in all these it contended Slipknot brand infringed. The argument ignores altogether the testimony of the independent expert from Rohm & Haas and the testimony of Plymouth's expert Mr. DeBell that some molecules under 1000 were in the *Sears* plasticizers just as here (R. 111, 119, 120, 309). It ignores the fact that not one of Minnesota's four experts (two of whom were employees) disagreed with this, and one of them admitted, in answer to the question "where you have looked for low molecular weight fraction below 1,000 have you found it?", that he had (R. 208). It ignores the uncontradicted testimony of Minnesota's own employee expert in *Sears* that molecules of weight under 1000 were there involved (respondent's Court of Appeals Brief for Appellee Appendix A-1 through A-15).* All this it seeks to do by giving to cer-

*The material in respondent's Court of Appeals Appendix A is reprinted from the record in *Sears*, which was filed in this Court on petition for *certiorari*, October Term, 1957, No. 673, and so is properly subject to judicial notice. *National Fire Ins. Co.* v. *Thompson*, 281 U. S. 331, 336 (1930).

The reference to 1000 as a floor first came in the testimony of one of Minnesota's chemists, Tierney (A-2). When he first used it even that way, for G-25, he was speaking of (A-4) "the weight average".

tain answers to requests for admissions its own hyper-technical and truth-defeating interpretation. However, the practical concern in formulating plasticizers is for significant quantities by weight (supra 13, footnote); and read in this context the answers give Minnesota no comfort. Even if the answers be simply ambiguous in this respect, the record clarifies them. Certainly Minnesota's interpretation, not accepted by the lower courts, should not be allowed to defeat truth here, where Minnesota did not object to evidence to the contrary at the trial (and indeed both offered such evidence, R. 31, and elicited it on cross-examination, eg. R. 309)*, and where its own chemists knew the untruth of the asserted interpretation.** (Minnesota's sugges-

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and remarked that this was "specifically more important [than number of molecules] where any formulation that requires weight of material, is specified. . . ." He went on to note that his low (bottom 33%) fraction of G-40 had from "1 to 20 links" (with number average of 2500 and weight average of 5300) and his low fraction of G-25 from 1 to 36 links (A-5). When asked if this was not inconsistent with his mention of 1000 (A-7) he replied (A-8) that in mention of a range from 1000 up he had been giving "the approximate range" (which might of course be so given with equal truth here). He went on (A-8): "[T]here may very well have been a small portion that would be from five hundred . . ." He repeated and amplified this later (A-9). DeBell, although his early testimony could initially have been construed otherwise (A-11), made it plain that his testimony on individual molecules was based not on experiment but solely on dividing the 1000 he understood Tierney to have used as a floor by the weight of the building blocks (A-14).

(The definitions of number average and weight average molecular weights were through mistake in error in the brief to which Appendix A is attached; this was subsequently corrected below.)

*Judicial admissions should be dealt with in a manner promoting substantial justice. Wigmore, "A Treatise on the Anglo-American System of Evidence on Trials at Common Law", v. 9, pp. 587-8 (3 Ed. 1940). Even pleadings should be treated as amended to conform to evidence admitted without objection on questions thus tried with implied consent. F. R. Civ. P. 15(b).

**_Russell-Miller Milling Co._ v. _Todd_, 198 F. 2d 166, 169 (5 Cir. 1952), in which one party obtained from another a stipulation inconsistent with evidence known to it.

tion that *Sears* turned on a 1000 dividing line flies in the face of the opinions as well as the record there. The figure was only mentioned in connection with a "for example" mention of one of the two resinous plasticizers there in issue [supra 6]. The figure 600 might with greater force be urged, for at least it was used in connection with a class of plasticizers. The real truth is that the decision did not turn on any specific molecular weight dividing line.)

c. Minnesota's argument that the plasticizers are different because the low fraction here was assertedly "migrating" and the low fraction there not is similarly without merit. When the continuum of a resinous plasticizer is cut into two fractions, the characteristics of the lower fraction naturally turn on how big the fraction is.* This is illustrated by Dr. Mark's work relied on by Minnesota: When the cut was the lowest 1.3%, number average molecular weight was 252; when the cut was the lowest 10.35%, the number average was 600. These data were from G-40 tapes (R. 249-252). The fraction of G-40 taken in *Sears* was 33% (R. 30). Mr. DeBell testified (R. 313):

> "I don't think we can compare, say, a 20 per cent cut . . . with some other cut, whatever it is, that is not in this vicinity.
>
> * * *
>
> *"There are low cuts and low cuts."*

2. Even if (contrary to fact) the District Court's finding of fact of tape sameness was clearly erroneous, the

*Minnesota urges that "its proof is wholly unlike that before the Fourth Circuit" (Pet. 6). It could have relied on smaller low fractions in *Sears*, had it chosen to do so.

"question presented" by petitioner would not be dispositive because of the concurrent findings of fact by the lower courts that Plymouth used no plasticizer that was "liquid" in the sense of the patent, as adjudicated between these parties in *Sears*. As the Court of Appeals said (Pet. 14a) in addition to what has already been quoted (supra 8-9):

> "Once ferreted out the determinative issue . . . becomes relatively simple. But to drive the quarry out of its burrow we must analyse the patent and review this and other litigation between the parties over it."

This freedom from "liquid" plasticizer collaterally estops Minnesota's present assertion of infringement even assuming (contrary to fact) the sort of plasticizer change petitioner urges. Minnesota in its conduct since *Sears* and in its very statement here of the alleged "question presented" seems unwilling to recognize that total identity of evidence presented, even to its form, is not a prerequisite of collateral estoppel. Its assertion that the decision below is "in apparent conflict" with *Cromwell v. County of Sac*, 94 U. S. 351 (1876) and other collateral estoppel decisions of this Court is without merit, a compound of petitioner's misconception of what collateral estoppel is and its refusal to accept findings of fact made below.

3. The asserted "question presented" is not dispositive because additionally of the judgments entered pursuant to each of the Chicago (supra 9) and *United States Rubber* (supra 10) decisions. Although Slipknot-branded tape was not itself within the complaints, that this precise tape did not infringe was actually litigated in each, and the determination that it did not was essential to the judgment in each ("Restatement, Judgments", § 68 and *Comment n* thereto, pp. 293, 307). Minnesota's attempt below to ignore them because on summary judgment was without merit, *Morris v. Jones*, 329 U. S. 545, 550-1 (1947). So too was

its argument that these grounds of res judicata, specifically emphasized at least as early as Plymouth's pre-trial brief, and within the general pleading allegations of res judicata, were not properly before the courts.

4. Both below and here Minnesota has closed its eyes to the manner in which it narrowed its original claims to avoid rejection. From a claim to a liquid plasticizer generally as one component of the two-component plasticizer mixture, the claims were narrowed to call for a *phthalyl ester* type of liquid plasticizer; there is not even any contention that Plymouth has used a phthalyl ester. At the same time, from a claim in which the liquid part of the plasticizer had no bottom limit, amendment was made to make 8 parts per 100 parts of plastic the floor. File wrapper estoppel would prevent infringement even if the judgment were the first as between these parties.* *Minnesota Mining & Mfg. Co. v. Permacel-LePage's Inc.*, ——F. Supp. ——, 139 USPQ 41, 43 (N. D. Ill. 1963). The weights Minnesota used in the present action were of fractions identified in terms of "number averages", although its own witness had conceded

*When broader claims have been surrendered and narrower accepted to overcome a Patent Office rejection, recapture of the broader claims through assertion of the doctrine of equivalents is sternly prohibited. *Exhibit Supply Co. v. Ace Corp.*, 315 U. S. 126 (1942). This is so even assuming (for present purposes only) that the Patent Office was in error. *Exhibit Supply*, 315 U. S. 126, 137. It is so too whether the rejection overcome by the cancellation or amendment was on the ground of prior art, or of indefiniteness (of which functionality is an aspect), *Parke, Davis & Co. v. American Cyanamid Co.*, 207 F. 2d 571, 574 (6 Cir. 1953), or of both, as here. File wrapper estoppel cannot be avoided by a purported "reservation" (like petitioner's, R. 561-2) of right to recapture in court on an equivalents theory what was surrendered to induce grant of the patent. *Johnson Furnace & Engineering Co. v. Western Furnace Co.*, 178 Fed. 819, 824 (8 Cir. 1910); *Thomas v. Rocker Spring Co.*, 77 Fed. 420, 431 (6 Cir. 1896; Judge [later Mr. Justice] Taft), cert. den'd 168 U. S. 709; *Parke, Davis & Co. v. American Cyanamid Co.*, 207 F. 2d 571, 574 (6 Cir. 1953).

that when, as here, parts by weight is the question, the important average is the weighted "weight average" [supra 13, footnote]; and his testimony there as well as Mr. DeBell's here [R. 287] indicates that weight average tends to run about twice number average. Petitioner, further, does not deny that its cuts of "number average" below 1000 include molecules above 1000, inconsistently with its own artificially contrived "under 1000" theory, the weight of molecules actually under 1000 being completely unproved.)

5. As an alternative ground for holding that Plymouth did not infringe, it was held in *Sears* that if the "dubious" (R. 425) new plasticizer definition in the claims new in the reissue be construed (as Minnesota contended they should be, R. 419) as not requiring any "liquid" plasticizer, they were void.* That Plymouth has not infringed these claims is res judicata for this reason as well. (Plymouth's invalidity defenses, including this one, were improperly struck by Judge McCarthy, who did not try the case, but whose ruling Judge Caffrey did not think it seemly to review [Pet. 2a]. Plymouth's appeal, which was in any event unnecessary to bring up error in this ruling as an alternative ground supporting the judgment in its favor [e.g., *G. Leblanc Corporation* v. *H. & A. Selmer, Inc.*, 310 F. 2d 449, 454-5 (7 Cir. 1962) cert. den'd 373 U. S. 910] was dismissed as moot [Pet. 20a, 25a]. These defenses were struck on Minnesota's extraordinary argument that the old District Court

*A claim added by reissue which seeks to make non-essential what the original application taught essential is invalid. *U. S. Chemicals Co.* v. *Carbide Corp.*, 315 U. S. 668 (1942).

Reissue is also improper, and claims thus obtained invalid, unless omitted originally by mistake rather than in exercise of strategic judgment to obtain grant of the original patent. Cancellation of a broader claim, as here, shows lack of mistake in the sense prerequisite to a proper reissue. *Dobson* v. *Lees*, 137 U. S. 258, 265-6 (1890). That the broader original claim canceled to accept a narrower one is made even broader by reissue application does not justify recapture within the latter of what was intentionally forgone.

judgment in *Sears*, although reversed and vacated, adjudicated in the loser's favor something that could not have been essential to the only final judgment left outstanding [R. 62].)

6. The extent to which Minnesota has abused its access to our nation's Courts is simply shocking. Petitioner was urging that "G-25 had changed significantly over the years" in petitioning in this Court for certiorari in *Sears* (Oct. Term 1957, No. 673, p. 10). It still is. Five lengthy decisions of Courts of Appeals alone have been necessitated, three since then; in addition to those already mentioned was one in another customer suit, *Minnesota Min. & Mfg. Co.* v. *Superior Insulating Tape Co.*, 284 F. 2d 478, 482 (8 Cir. 1960), in which the Court commented:

> "There is reason to believe that there should be some limit to the number of times the courts should be required to consider claims involving identical issues."

The District Court in the present action adopted this language from Plymouth's brief as "aptly" descriptive of this "litany of litigation" (Pet. 2a, 9a):

> "The customer cases constitute a story of proliferation of litigation on a single issue, abuse of judicial process, persistent trying of identical issues in different courts, and oppression and harassment unequaled in our experience. We know of nothing quite like it in the reported cases."

The Courts below held that in view of this history of litigation, further suits of this sort should be enjoined (Pet. 11a, 25a). We submit that it is indeed time Plymouth be allowed to enjoy peacefully the fruits of its successful defense.

Conclusion

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

Respectfully submitted,

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